

REMARKS/ARGUMENTS

Claims 21-27 and 29-59 are pending, claims 29-32 and 40-43 having been withdrawn from consideration. By this Amendment, claim 28 is cancelled, and claims 21-27, 29, 30, 32, 33, 39-41, 43, 44 and 50 are amended. Support for the amendments to claims 21-27, 29, 30, 32, 33, 39-41, 43, 44 and 50 can be found, for example, in the present specification at page 10, lines 6 to 7, and in original claims 21-27, 29, 30, 32, 33, 39-41, 43, 44 and 50. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Information Disclosure Statement

The initialed Form PTO-1449 attached to the Office Action does not include an indication that each of the references cited in the June 22, 2005 Information Disclosure Statement has been considered by the Examiner (*see* JP 62-114985, DE 102 46 140, Smith, Gordon J., "Aminoxide," Seifen-Oele-Fette-Wachse, vol. 105, pp. 319-322, 345-347, 1979). The Office Action asserts that the translations of the above references were not provided. Applicants submit that the significance of JP 62-114985 is discussed in the International Search Report (in the English language) provided with the June 22, 2005 Information Disclosure Statement. Applicants submit that the significance of DE 102 46 140 and the Smith article is discussed in the present specification (*see, e.g.,* present specification, pages 2, 6). Applicants respectfully request that the Examiner consider of each of the cited references, indicate such consideration on the attached Form PTO-1449, and return the initialed form to the undersigned. *See* MPEP §609.04(a)III.

Withdrawn Claims

Applicants respectfully disagree with the Office Action's assertion that the claims to the present application do not relate to a single inventive concept under PCT Rule 13.1. However, for the reasons set forth below, Applicants submit that all pending claims presently subject to examination are in condition for allowance. Because the withdrawn claims depend from, and thus recite all features of, allowable claims subject to allowance, rejoinder and allowance of the withdrawn claims are respectfully requested.

Priority Claim

The Office Action asserts that Applicants' priority claim is denied because an English-language translation of the application to which the present application claims priority has not been submitted. Applicants submit that the priority claim in the present application is proper. *See* 37 C.F.R. §1.55. The Office Action appears to confuse "claiming" priority with "perfecting" priority. Although Applicants reserve the right to do so in the future, at present Applicants need not rely on the priority filing date to overcome the outstanding rejection, so no English-language translation of the priority application is required.

Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 21-28 under the written description requirement of 35 U.S.C. §112, first paragraph. By this Amendment, claim 28 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, although Applicants do not necessarily agree with the rejection, by this Amendment, claims 21-27 have been amended to render the rejection moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 21-28, 33-39 and 44-59 as indefinite under 35 U.S.C. §112, second paragraph. By this Amendment, claim 28 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

The Office Action asserts that recitation of the degree of branching recited in the present claims renders the claims unclear and confusing. *See* Office Action, pages 3 to 4. Applicants submit that one of ordinary skill in the art could readily discern whether an R¹ substituent does or does not possess the degree of branching required by the claims. That is, one of ordinary skill in the art could determine whether or not a particular compound fall within or outside of the scope of the claims. No further clarity or precision is required.

The Office Action asserts that the required branching arises from the use of technical grade alcohols, and that because such alcohols are acquired that the recited branching has no patentable significance. Applicants submit that there is no legal justification for this assertion. The patentability of, e.g., claim 21, is determined based on the structure of the recited alkylglycidol carbonate or mixture of alkylglycidol carbonates, not the commercial availability of the reactants used to prepare the alkylglycidol carbonate or mixture of alkylglycidol carbonates. As discussed below, the degree of branching of R¹ substituent distinguishes the claimed alkylglycidol carbonate or mixture of alkylglycidol carbonates over the compositions disclosed in the cited references. Moreover, alkylglycidol carbonates or mixtures of alkylglycidol carbonates including an R¹ substituent having the recited branching provide superior effectiveness as cosurfactants and have good environmental compatibility. However, even if such were not the case, the metes and bounds of the present claims are clear, so the claims are definite.

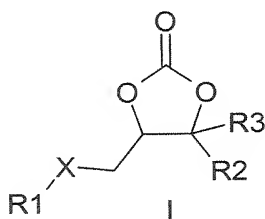
For the foregoing reasons, claims 21-27, 33-39 and 44-59 are definite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §102

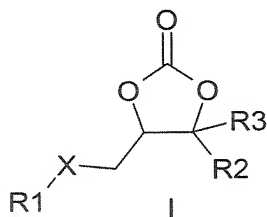
A. Horibe

The Office Action rejects claims 21-24, 27, 28, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 under 35 U.S.C. §102(b) over JP 2001-300286 to Horibe et al. ("Horibe"). By this Amendment, claim 28 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

Claim 21 recites "[a]n alkylglycidol carbonate or mixture of two or more alkylglycidol carbonates of the formula I



in which the symbols X, R¹, R² and R³ have the following meanings: R¹ is an unsubstituted C₃-C₂₉-alkyl group or an unsubstituted C₃-C₂₉-alkenyl group, wherein the substituent R¹ has an average degree of branching which is defined as (number of methyl groups per molecule)-1 of from 0.2 to 1.6 ... (emphasis added). Claim 27 recites "[a]n alkylglycidol carbonate or mixture of two or more alkylglycidol carbonates of the formula I



in which the symbols X, R¹, R² and R³ have the following meanings: R¹ is an unsubstituted C₃-C₂₉-alkyl group or an unsubstituted C₃-C₂₉-alkenyl group, wherein the substituent R¹ has

an average degree of branching which is defined as (number of methyl groups per molecule)-1 of from 0.2 to 1.6 ..." (emphasis added). Horibe does not disclose or suggest such alkylglycidol carbonates or mixtures of alkylglycidol carbonates.

The Office Action asserts that Horibe discloses the compound of formula I, as recited in claims 21 and 27. *See* Office Action, page 4. The Office Action correctly points out that Horibe discloses alkylglycidol carbonates. *See* Horibe, Abstract. However, in each of the compounds disclosed in Horibe, the substituent corresponding to R¹ in formula I of claims 21 and 27 is linear. That is, the alkylglycidol carbonates of Horibe do not have substituents corresponding to R¹ in formula I that are branched at all, much less with an average degree of branching of from 0.2 to 1.6, as recited in claims 21 and 27.

As Horibe fails to disclose or suggest alkylglycidol carbonates or mixtures of alkylglycidol carbonates according to formula I in which the substituent R¹ has an average degree of branching of from 0.2 to 1.6, Horibe fails to disclose or suggest each and every feature of claims 21 and 27.

As explained, claims 21 and 27 are not anticipated by Horibe. Claims 22-24, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 depend variously from claims 21 and 27 and, thus, also are not anticipated by Horibe. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Mouloungui

The Office Action rejects claims 21-24, 27, 28, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 under 35 U.S.C. §102(b) over Mouloungui et al., Eur. J. Lipid Sc. Tech. 2001 Vol. 103(4), pp. 216-212 ("Mouloungui"). By this Amendment, claim 28 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

Claims 21 and 27 are set forth above. Mouloungui does not disclose or suggest such alkylglycidol carbonates or mixtures of alkylglycidol carbonates.

The Office Action asserts that Mouloungui discloses the compound of formula I, as recited in claims 21 and 27. *See* Office Action, page 5. The Office Action correctly points out that Mouloungui discloses alkylglycidol carbonates. *See* Mouloungui, Abstract. However, in each of the compounds disclosed in Mouloungui, the substituent corresponding to R¹ in formula I of claims 21 and 27 is linear. That is, the alkylglycidol carbonates of Mouloungui do not have substituents corresponding to R¹ in formula I that are branched at all, much less with an average degree of branching of from 0.2 to 1.6, as recited in claims 21 and 27.

As Mouloungui fails to disclose or suggest alkylglycidol carbonates or mixtures of alkylglycidol carbonates according to formula I in which the substituent R¹ has an average degree of branching of from 0.2 to 1.6, Mouloungui fails to disclose or suggest each and every feature of claims 21 and 27.

As explained, claims 21 and 27 are not anticipated by Mouloungui. Claims 22-24, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 depend variously from claims 21 and 27 and, thus, also are not anticipated by Mouloungui. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

C. Tashiro

The Office Action rejects claims 21-24, 27, 28, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 under 35 U.S.C. §102(b) over JP 1991-03065232 to Tashiro et al. ("Tashiro"). By this Amendment, claim 28 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

The Office Action asserts that Tashiro discloses the compound of formula I, as recited in claims 21 and 27. *See* Office Action, page 6. The Office Action correctly points out that Tashiro discloses alkylglycidol carbonates. *See* Tashiro, Abstract. However, in each of the compounds disclosed in Tashiro, the substituent corresponding to R¹ in formula I of claims 21 and 27 is linear. That is, the alkylglycidol carbonates of Tashiro do not have substituents corresponding to R¹ in formula I that are branched at all, much less with an average degree of branching of from 0.2 to 1.6, as recited in claims 21 and 27.

As Tashiro fails to disclose or suggest alkylglycidol carbonates or mixtures of alkylglycidol carbonates according to formula I in which the substituent R¹ has an average degree of branching of from 0.2 to 1.6, Tashiro fails to disclose or suggest each and every feature of claims 21 and 27.

As explained, claims 21 and 27 are not anticipated by Tashiro. Claims 22-24, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 depend variously from claims 21 and 27 and, thus, also are not anticipated by Tashiro. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

D. Kawabata

The Office Action rejects claims 21-24, 27, 28, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 under 35 U.S.C. §102(b) over JP 1985-60228472 to Kawabata et al. ("Kawabata"). By this Amendment, claim 28 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

The Office Action asserts that Kawabata discloses the compound of formula I, as recited in claims 21 and 27. *See* Office Action, page 6. The Office Action correctly points out that Kawabata discloses alkylglycidol carbonates. *See* Kawabata, Abstract. However, in each of the compounds disclosed in Kawabata, the substituent corresponding to R¹ in

formula I of claims 21 and 27 is linear. That is, the alkylglycidol carbonates of Kawabata do not have substituents corresponding to R¹ in formula I that are branched at all, much less with an average degree of branching of from 0.2 to 1.6, as recited in claims 21 and 27.

As Kawabata fails to disclose or suggest alkylglycidol carbonates or mixtures of alkylglycidol carbonates according to formula I in which the substituent R¹ has an average degree of branching of from 0.2 to 1.6, Kawabata fails to disclose or suggest each and every feature of claims 21 and 27.

As explained, claims 21 and 27 are not anticipated by Kawabata. Claims 22-24, 33, 34, 36-39, 44, 45, 47, 48, 50, 51, 54, 55 and 58 depend variously from claims 21 and 27 and, thus, also are not anticipated by Kawabata. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103

The Office Action rejects claims 21-28, 33-39 and 44-59 under 35 U.S.C. §103(a) over Horibe, Mouloungui, Tashiro and Kawabata in view of U.S. Patent No. 3,320,174 to Rubinfeld ("Rubinfeld"), WO 97/04059 to Durbut et al. ("Durbut 059"), WO 98/00418 to Durbut et al. ("Durbut 418"), and U.S. Patent No. 5,994,290 to Potthoff-Karl et al. ("Potthoff-Karl"). By this Amendment, claim 28 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

For the reasons discussed above, each of Horibe, Mouloungui, Tashiro and Kawabata fails to disclose or suggest each and every feature of claims 21 and 27. Rubinfeld, Durbut 059, Durbut 418 and Potthoff-Karl fail to remedy the deficiencies of Horibe, Mouloungui, Tashiro and Kawabata. Each of Rubinfeld, Durbut 059, Durbut 418 and Potthoff-Karl is cited for its alleged disclosure of surfactant/detergent compositions. However each of Rubinfeld, Durbut 059, Durbut 418, Potthoff-Karl, like each of Horibe, Mouloungui, Tashiro

and Kawabata, fails to disclose or suggest alkylglycidol carbonates or mixtures of alkylglycidol carbonates according to formula I in which the substituent R¹ has an average degree of branching of from 0.2 to 1.6. Accordingly, the combination of references fails to disclose or suggest each and every feature of claims 21 and 27

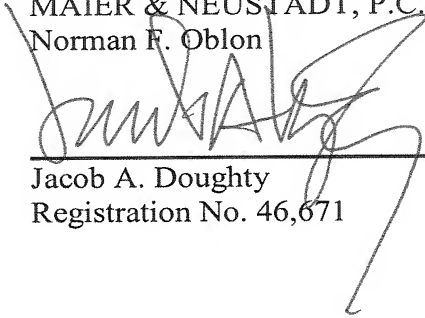
As explained, claims 21 and 27 would not have been rendered obvious by Horibe, Mouloungui, Tashiro, Kawabata, Rubinfeld, Durbut 059, Durbut 418, and Potthoff-Karl. Claims 22-26, 33-39 and 44-59 depend variously from claims 21 and 27 and, thus, also would not have been rendered obvious by the cited references. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, Applicants submit that claims 21-27 and 29-59 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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